

Serial No. 10/759,706

REMARKS

Takagi is for a different purpose and does not face or solve the problems faced and solved by the present invention. As an example, ports 32 and 33 "are provided so that fluids of different refractive indices can be caused to continuously flow in and out through the inlet aperture and the outlet aperture while adjusting the characteristic values," (column 4, line 66 to column 5, line 2) and in particular there is no suggestion that air be evacuated so that the housing can be completely filled and then stopped. Claim 1 has been amended to more clearly define the present invention in a manner to distinguish over the prior art. Furthermore, claim 2 has been incorporated into claim 1, with the Examiner recognizing that Takagi does not suggest the recitations of claim 2.

It should be appreciated that the reasons provided by the Examiner to show that the alleged modifications to Takagi are based upon the hindsight knowledge of the present invention for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd., v. Union Oil Co. of Cal.*, 218 U.S.P.Q. 865, 870 (1983) stated:

All the pieces of the present invention were known in the art,... That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art. (Case citations.)

Further, the CAFC in *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Furthermore, the CAFC in *American Hoist & Derrick Co., v. Sowa & Sons, Inc.*, 220 U.S.P.Q. 763, 771 (1984) quoted:

A patentable invention *** may result even if the inventor has in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs.)

Similarly, the Court of Appeals for the Federal Circuit in *In re Sernaker*, 702 F.2d 989,

Serial No. 10/759,706

217 U.S.P.Q. 1, 5 (1983) stated:

We may assume, for purposes of this decision, that all the prior art references in this case are sufficiently related to one another and to a related and common art, that the hypothetical person skilled in the art must be presumed to be familiar with all of them. That being so, the next questions are (a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and (b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.

As an example, the Examiner argues that Takagi should be modified "for the purpose of protecting the electronic device". Does the Examiner contend that the electronic device in Takagi is not protected or needs protection? Takagi does not in any way suggest that its structure is deficient or suggest the possibility or desirability of further improvement in the ability "of protecting the electronic device". Likewise, Takagi does not suggest that its structure is deficient or suggest the possibility or desirability of further improvement in the ability to evacuate air from its enclosure. It is respectfully submitted the prior art does not suggest the possibility of achieving further improvement along the lines of the present invention. Specifically, it is respectfully submitted that the Examiner has simply scanned the art in an attempt to find elements conceded not found in Takagi, and once such elements are found somewhere has reconstructed the present invention in a manner which was not suggested as being desirable in the prior art and for purposes which are not taught by the prior art. It is respectfully submitted that the conclusion of obviousness is based upon an impermissible hindsight reconstruction of the art, and the rejection has been overcome

By the lack of application of references like the cited references within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of these references.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicant's waterproof, vibration-proof, and heat dissipative housing of an electronic element which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner, whether those references are taken

Serial No. 10/759,706

singly or in any combination, the Examiner is requested to allow claims 1 and 3-7, as amended, of the present application and to pass this application to issue.

Respectfully submitted,

Louis Chuang



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Alan D. Kamrath, Reg. No. 28,227
NIKOLAI & MERSEREAU, P.A.
Attorneys for Applicant(s)
900 Second Avenue South
Suite 820 International Centre
Minneapolis, MN 55402
Tel: (612) 392-7306
Fax: (612) 349-6556